

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

TANG, Yiwen

Art Unit: 1618

Serial No.: 10/719,516

Examiner: Rogers, James William

Filed: 21 November 2003

Confirmation No.: 3018

For: COATINGS FOR IMPLANTABLE
DEVICES INCLUDING
BIOLOGICALLY ERODABLE
POLYESTERS AND METHODS
OF FABRICATING SAME

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This reply brief is in response to the Examiner's Answer mailed 19 February 2010.

STATUS OF CLAIMS

The current status of the claims is:

Claims 1-4, 6-8, 11-18, 20, 21, 23-25 and 28-34 are pending and are hereby appealed.

Claims 5, 9, 10, 19, 22, 26, 27, have been canceled.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed in this appeal are:

1. Whether claims 1-4, 6-8, 11, 15, 17, 18, 20, 21, 23-25, 28 and 32 are anticipated by Lee, WO 01/21229 (Evidence Appendix, Exhibit "A"), under 35 U.S.C. § 102(b).
2. Whether claims 1-3, 6-8, 11-18, 20, 23-25 and 28-32 are anticipated by Hossainy, EP 0 970 711(Evidence Appendix, Exhibit "B", Hossainy I), under 25 U.S.C. § 102(b).
3. Whether claims 1-3, 6-8, 11, 15, 17, 18, 20, 23-25, 28 and 32-34 are anticipated by DeSimone, et al., US 2004/0181271 (Evidence Appendix, Exhibit "C") under 353 U.S.C. § 102(e).
4. Whether claims 1-3, 6-8, 11-15, 17, 18, 20, 23-25 and 28-34 are unpatentable under 35 U.S.C. § 103 over DeSimone, US 2004/0181271 (Evidence Appendix, Exhibit "C").

ARGUMENT

It is first noted that the examiner, in the Examiner's Answer, states that the following rejections previously presented and addressed in the Appeal Brief in this action have been withdrawn:

Whether claims 1-3, 6-8, 11, 15, 17, 18, 20, 23-25, 28 and 32-34 are anticipated by Hossainy, et al., US 2001/0014717(Evidence Appendix, Exhibit "D", Hossainy II), under 35 U.S.C. § 102(b).

Whether claims 1-3, 6-8, 11-15, 17, 18, 20, 23-25 and 28-34 are unpatentable under 35 U.S.C. § 103 over Hossainy, et al., US 2001/0014717(Evidence Appendix, Exhibit "D", Hossainy II).

In view of the withdrawal of the above rejections, they will not be dealt with further herein.

With regard to the remaining rejections over Lee, Hossainy and DeSimone, in the Examiner's Answer the examiner begins by iterating the grounds for rejection previously presented in the 18 April 2008 and 2 July 2009 non-final office actions (Exhibits "E" and "F" to the Appeal Brief) from which appeal was taken.

The examiner then addresses some of the points raised in appellants' appeal brief.

The first attack on appellants' arguments presented by the examiner relates to appellants contention that none of the references cited by the examiner mention the Tg or the degree of crystallinity of the polymers disclosed in those references while such properties and specific relationships between those properties of two distinct sets of polymers are expressly claimed in the instant invention. The examiner's response is that the references disclose the "same polymers" as appellants and that those polymers would inherently present the same physical properties as claimed by appellants in claim 1 of the application. As will be explicated below, the examiner's position that Lee, Hossainy and/or DeSimone disclose the same polymers is erroneous.

The second of appellants' points that the examiner takes umbrage with is appellants' argument that the cited references disclose so many polymers – without so much as a tangential nod toward any specific polymers or blends of those polymers - that it would be well-nigh impossible to draw from those huge pools of polymers specific subsets that meet the limitations of the current invention absent prior knowledge of those limitations, i.e., hindsight. The examiner, however, once again argues that Lee, Hossainy and DeSimone actually disclose the "same polymers" as the present invention and therefore somehow disclose the same blends.

With regard to the examiner's first position regarding physical properties and inherency, appellants believe that the arguments presented in the Appeal Brief remain dispositive of the issue and the examiner has brought up nothing to contradict appellants' position.

With regard to the examiner's second argument, Appellants respectfully suggests that the Board need only scan the passages of Lee (Appeal Brief Exhibit "A", claim 26), Hossainy (Appeal Brief Exhibit "B", page 3, line 57 – page 4, line 3 (and much more that the examiner disingenuously ignores) and DeSimone (Appeal Brief, Exhibit "C", claim 39) cited by the examiner to immediately recognize the fault in the of the examiner's reasoning. For example, claim 26 of Lee reads:

26. The stent of claim 15, wherein the biodegradable materials include polyacids, such as poly(3-hydroxybutyrate-3-hydroxyvalerate), poly(amino acids), polycaprolactone, poly-epsilon-caprolactone, poly-ester-based biodegradable materials, poly(aminocaproic acid), polyanhydrides, polyorthoesters, polypeptides, such as polylysine, polyglycolic acids, polylactic acids, genetically engineered proteins, genetically engineered polysaccharides, genetically engineered DNAs and RNAs, copolymers, blends and combinations thereof.

From this the examiner argues that the skilled artisan would be inevitably drawn to blends of PHB, PCL, PGA and PLA in the very specific combination of the instant invention. Yet, Lee offers no basis whatsoever for selecting one polymer or one family of polymers over any another set forth above, for separating the polymers into two subsets and for blending one subset of polymers with another subset of polymers, both subsets being selected from the claimed single set of polymers. Simply put, the examiner's argument is specious.

The situation is exactly the same with Hossainy and DeSimone. In Hossainy the list of possible polymers goes on for six paragraphs, [0021] – [0026], and covers three very small print pages – not merely the introductory paragraph cited by the examiner. The possible polymer blends are virtually incalculable. While it may be true that by diligent effort the examiner was able to extract from the morass of polymers set forth in Hossainy some of the polymers of the instant invention, this was indisputably due to the

examiner's knowledge of exactly what the examiner was looking for. The person of ordinary skill in the art, not having the instant application as a template, would have no such luxury and without it would virtually never be able to extract the instant invention from Hossainy.

While claim 39 of DeSimone is admittedly substantially narrower than the disclosure of Hossainy, and perhaps even that of Lee's claim 26, it is no more revealing of the instant invention than those references. Buried within the bowels of DeSimone's claim 39, it may be possible to individually find most of the polymers expressly set forth in the instant invention – buried amid many, many others. But DeSimone says nothing whatsoever about grouping the polymers into two distinct sets with very different physical properties and then blending polymers only from the two sets.

CONCLUSION

The examiner's answer does nothing to counter the clearly dispositive arguments promulgated by appellants in the Appeal Brief. The examiner's additional arguments directed expressly at appellants' contentions in the Appeal Brief fail utterly to cast any doubt over the correctness of appellants' position.

Appellants respectfully renew their request that the Board reverse the examiner's rejection and order that the application proceed to issue.

Date: 19 April 2010	Respectfully submitted,
Squire, Sanders & Dempsey L.L.P.	
One Maritime Plaza, Suite 300	<u>/Bernard F. Rose/</u>
San Francisco, CA 94111-3492	Bernard F. Rose
(415) 954-0200	Reg. No. 42,112